UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,189	02/25/2004	Sehyun Kim	47003.010004	2389

41068 7590 12/13/2006

BUCHANAN INGERSOLL PC
1835 MARKET STREET, 14TH FLOOR
PHILADELPHIA, PA 19103-2985

EXAMINER	
NUTTER, NATHAN M	
ART UNIT	**PAPER NUMBER**
1711	

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/786,189	KIM, SEHYUN	
	Examiner	Art Unit	
	Nathan M. Nutter	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 24 October 2006 has been entered.

Response to Amendment

In view of the arguments presented in the paper filed 24 October 2006, the following is placed in effect.

The rejection of claims 1-5 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yunoki et al (US 6,639,018), is hereby expressly withdrawn.

The Declaration of Sehyun Kim filed on 24 October 2006 under 37 CFR 1.131 is sufficient to overcome the Yunoki et al reference. The Declaration is deemed sufficient to establish a reduction to practice date of 16 July 2001, the date ascribed the Research Memorandum of Exhibit B. The e-mail transcript of Exhibit A is not convincing to establish an earlier date of reduction to practice since it cannot be ascertained what the email contained as attachments. Further, there has been no establishment of due

diligence prior to 16 July 2001. As such, the reference to Yunoki et al cannot be deemed prior art to the instantly claimed invention.

Other rejections of record are being maintained, as follows.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 3-5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 6 of copending Application No. 10/844,640. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compositional limitations of the application embrace those with regard to the polymers and their monomeric constituents. Further, the xylene solubles content of the homopolymer embrace those

as recited herein. The copending application at claim 6 shows the in-reactor blending, as recited in instant claim 3.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fujita et al (US 6,346,580).

The patent to Fujita et al (US 6,346,580) teaches the manufacture of a propylene resin blend composition that may include a propylene homopolymer (designated polymer (B-1) in the patent) with a random ethylene-propylene copolymer (designated polymer (B-2) in the patent) that may overlap in compositional limitations with those recited and claimed herein. Note column 7 (lines 32-45) and column 8 (lines 14-26). The

homopolymer is disclosed as crystalline having a xylene extractable of "0.10% by weight" at the Reference Example 6. That example also shows an ethylene monomer content for the ethylene-propylene block as being "4.7% by weight." The employment of a filler material or other additive is shown at column 9 (lines 39-46) (claim 4).

Where the constituents overlap in compositional limitations, the claims are deemed to be anticipated by the reference. Since all other parameters are essentially identical, the recitations of the instant claims are deemed to be at least obvious, if not anticipated, by the reference to Fujita et al (US 6,346,580).

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dang et al (US 6,225,411).

The reference to Dang et al (US 6,225,411) teaches the manufacture of a propylene polymer blend that may comprise an isotactic (crystalline) propylene homopolymer with a propylene-ethylene copolymer that may comprise ethylene in an amount of "10% or less," which embraces the recitations of the instant claims. Note column 1 (line 55) to column 2 (line 11). At column 2 (lines 12-15), the reference shows the use of additives as recited in claim 4. The blend may be "in-reactor" (claim 3) at column 2 (lines 48-55). The compositional limitations are exemplified at Table 1 of column 5 and are deemed to embrace those recited and claimed.

The reference is silent with respect to the xylene solubles portion of the propylene homopolymer constituent, teaching how those values may be obtained at column 4 (lines 18-34). However, the reference shows production of the resins in

identical fashion as herein disclosed. As such, one would not expect there to be any difference in the characteristics of the resins employed. As such, since all other parameters are essentially identical, the recitations of the instant claims are deemed to be at least obvious, if not anticipated, by the reference to Dang et al (US 6,225,411).

Response to Arguments

Applicant's arguments filed 24 October 2006have been fully considered but they are not persuasive.

With regard to the provisional rejection of claims 1 and 3-5 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 6 of copending Application No. 10/844,640, no Terminal Disclaimer has been filed in this application to overcome this rejection.

With regard to the rejection of claims 1-5 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fujita et al (US 6,346,580), it is pointed out that the reference teaches the physical mixing of components A and B at column 9 (lines 32-46). This is echoed at Reference Example 6, column 13, for the production of the B-1 component. The reference teaches the production of A and the production of B with subsequent blending. When the polymer B component is made, it is deemed, at that point to anticipate, or at least render obvious, the instantly claimed invention. With regard to the passage at column 8 (lines 22-26) of

the reference to Fujita et al, applicants argue "explicitly states that the copolymers of Fujita contain from 20 to 60 percent ethylene." It is pointed out that the reference at that passage says "(t)he weight ratio of ethylene unit to propylene unit in the random copolymer (B2) is ***preferably*** 20/80 to 60/40 (emphases added)," and yet the reference teaches at Reference Example 6 an ethylene monomer content for the ethylene-propylene block as being "4.7% by weight." A reference is taken for the entirety of its teachings and not for isolated passages that refer to preferred embodiments. Applicants contend the equivalence of the reference copolymer, which is referred to as "random" copolymer (all that is required by the claims), with a copolymer in the Polypropylene Handbook submission. However, applicants ignore the disclosure of the reference and especially the Example 6 disclosure at column 13.

With regard to the rejection of claims 1-5 under 35 U.S.C. 103(a) as being unpatentable over Dang et al (US 6,225,411), it is pointed out that if the isotactic index is as low as 90, it could be as high as 100, making the xylene soluble content, as low as 0.0 wt %, by applicants' own calculations. Applicants are reminded that a reference is taken for the entirety of its teachings, and not solely for that taught in the reference Examples. Where the compositional limitations overlap with those recited herein, the reference is deemed to anticipate the claims. Otherwise, a skilled artisan would know what polymers would be suitable from the disclosure of Dang et al and have a great expectation of success to provide the composition as herein claimed. Further, applicants have not provided any evidence that the polymer of Dang et al would

"possess a high xylene solubles content." Again, the reference is viewed for the entirety of its teachings, and not for isolated passages or Examples.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nathan M. Nutter
Primary Examiner
Art Unit 1711

nmn

10 December 2006